

Please add Claim 12 as follows:

β' --12. (New) The aqueous ink composition according to claim 1,
wherein the polyhydric alcohol is selected from the group consisting of
popylene glycol, 1, 5-pentanediol, 1, 2, 6-hexanetriol, and hexlene glycol.--

REMARKS

Applicants respectfully request allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1-12 are pending in the present application. Claims 1 and 8-11 are the independent claims. Claim 12 is newly-presented. No new matter has been added.

In the final Office Action dated May 1, 2002, Claims 1-11 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 6,031,019 (Tsutsumi, et al.) in view of U.S. Patent No. 6,153,001 (Suzuki, et al.). Claims 1-11 also were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Suzuki, et al. in view of Tsutsumi, et al. Applicants respectfully disagree with these rejections.

In the Request for Reconsideration filed July 31, 2002, Applicants submitted evidence of unexpected results via a Declaration under 37 C.F.R. §1.132. Specifically, Applicants submitted a Declaration providing the Office with evidence that ethylene urea and urea give significantly different performances with respect to ink storage stability when added to an aqueous ink-jet ink containing a resin encapsulating a colorant and having a cationic hydrophilic group, and a cationic self-dispersing pigment, both dispersed in an aqueous medium. Further, Applicants submitted that this difference in performance is not disclosed or suggested by Tsutsumi, et al. Moreover, Suzuki, et al., treats urea and ethylene urea as equivalents, and does not teach or suggest the superiority

of ethylene urea over urea. Accordingly, the combination of Tsutsumi, et al. and Suzuki, et al. does not teach or suggest the advantageous effect of the present invention, and the present invention is not obvious over Tsutsumi, et al. in view of Suzuki, et al.

In the Advisory Action dated August 14, 2002, the Office took the position that the unexpected results shown by the Declaration were not persuasive because the specification as originally filed did not disclose that ethylene urea affects ink storage stability. (Attachment to Advisory Action, paragraph 5).

Applicants respectfully submit that the aforesaid position is contrary to applicable precedent and the Office's own procedures as set forth in the Manual of Patent Examining Procedure. Thus, Applicants submit that the evidence of unexpected results presented in the Declaration filed July 31, 2002 should be considered by the Office.

Initially, Applicants note that MPEP §2144.08 II.B. instructs that:

Office personnel should consider all rebuttal arguments and evidence presented by applicants.

That same MPEP section also recognizes that:

[r]ebuttal evidence and arguments [of nonobviousness] can be presented in the specification, . . . by counsel, . . . or by way of affidavit or declaration under 37 C.F.R. 1.132 . . .

Id. Similarly, MPEP 716.02(f), citing In re Chu, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995) warns that:

The totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. Therefore, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded.

In In re Chu, the Federal Circuit addressed the question of whether arguments and evidence concerning the advantages of a claimed invention should be considered when the applicant's specification was "virtually silent" about such unexpected results. In reversing the Board, the Federal Circuit answered the question in the affirmative, stating:

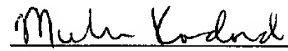
. . . the Board erred in apparently requiring Chu's evidence and arguments responsive to the obviousness rejection to be within his specification in order to be considered. To require Chu to include evidence and arguments in the specification regarding whether [the subject feature] was a matter of "design choice" would be to require patent applicants to divine the rejections the PTO will proffer when patent applications are filed.

Id. at 1094.

For the foregoing reasons, Applicants respectfully submit that the Declaration under 37 C.F.R. §1.132 filed July 31, 2002, should be considered by the Office. Further, Applicants submit that the claims patentably define the present invention over the citations of record for the reasons set forth in the Request for Reconsideration After Final Rejection filed on that date. Applicants also submit that newly presented Claim 12 patentably defines the present invention over the citations of record at least for the reasons set forth in the Request for Reconsideration regarding independent Claim 1.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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